



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|------------------------|---------------------|------------------|
| 10/087,627 | 03/01/2002 | Vincent Formale | RSW920020013 US1 | 3717 |
| 46270 7590 12/12/2007 IBM CORPORATION (SYL-RSW) C/O SYNNESTVEDT & LECHNER LLP 1101 MARKET STREET, SUITE 2600 PHILADELPHIA, PA 19107 | | | | |
| EXAMINER THEIN, MARIA TERESA T | | | | |
| ART UNIT 3627 | | PAPER NUMBER | | |
| MAIL DATE 12/12/2007 | | DELIVERY MODE PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/087,627

Applicant(s)

FORMALE ET AL.

Examiner

MARISSA THEIN

Art Unit

3627

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,7-11,17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,7-11,17 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 20, 2007 has been entered.

Response to Amendment

Applicants' "Request for Continued Examination" filed on September 20, 2007 has been considered.

Claims 1, 7, 9, and 17 are amended. Claims 2, 4-6, 12-16 are cancelled. Claims 1, 3, 7-11, and 17-18 remain pending in this application and an action on the merits follow.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 7-11, and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the book "Intermediate Accounting", (pages 499-521) (tenth

edition) in view of U.S. Patent No. 6,047,267 to Owens et al. and in further view of U.S. Patent No. 2002/0082966 to O'Brien

Regarding claims 1 and 9, Intermediate Accounting discloses classifying an asset as capital or an expensed asset (page 518) comprising: selecting a minimum capitalization value (page 518); receiving purchase data signifying the acquisition of an asset (page 501; page 502); determining a machine type of the acquired asset (page 50; page 502); comparing the value assigned to said machine type of the acquired asset to said minimum capitalization value (page 509; page 514); and if the value for the machine type of the acquired asset is greater than or equal to said minimum capitalization value, classifying the asset as a capital asset, and if the value of the machine type of the acquired asset is less than the minimum capitalization value, classifying the asset as an expensed asset (page 518).

However, Intermediate Accounting does not explicitly disclose assigning with respect to each of a plurality of machine types an average value of a model of said machine type independent of a value of the acquired asset; the models of the machine type; determining a value of the models; calculating the average value of the models; weighting the value of each model as a function of predicted purchasing trends of models; the value of the models are derived from the manufacturer's base manufacturing cost; and computer readable product embodied on computer readable media readable by a computing device.

Intermediate Accounting does disclose valuation of an asset (page 509). To properly reflect cost, assets purchased on long-term contracts are accounted for at the present value of the consideration exchanged between the contracting parties at the date of the transaction ("Deferred Payment Contract" page 509).

O'Brien, on the other hand, teaches assigning with respect to each of a plurality of machine types an average value of a model of said machine type independent of a value of the acquired asset. O'Brien teaches a benchmark value which is a numerical or financial value. The Numerical values can be aggregated, averaged, or otherwise manipulated or processed. (Paragraph 162) The benchmark information system is related to a particular asset against similar information for an entire group of similar assets. The system provides users with the ability to define the group of assets included in a particular analysis. (Paragraph 15) O'Brien further teaches benchmarking pool assets which can be selected on the basis of a shared characteristic, a shared data value for a particular characteristic (paragraph 159). Asset selection for benchmarking purposes should have some relevant characteristic or data value (paragraph 159). The benchmark characteristics include the type of asset (the type or model) paragraph 16). Furthermore, O'Brien teaches the models of the machine type (paragraph 37; paragraphs 160-162; paragraphs 166-167); determining a value of the models (paragraph 37; paragraphs 160-162; paragraphs 166-167); calculating the average value of the models (paragraph 37; paragraphs 160-162; paragraphs 166-167); weighting the value of each model as a function of predicted purchasing trends of models (paragraph 16; paragraph 137; paragraphs 75-77; paragraphs 158-162;

paragraphs 163-167); and the value of the models are derived from the manufacturer's base manufacturing cost (paragraph 16; paragraph 137; paragraphs 75-77; paragraphs 158-162; paragraphs 163-167).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the Intermediate Accounting, to include assigning with respect to each of a plurality of machine types an average value of a model of said machine type independent of a value of the acquired asset; the models of the machine type; determining a value of the models; calculating the average value of the models; weighting the value of each model as a function of predicted purchasing trends of models; and the value of the models are derived from the manufacturer's base manufacturing cost, as taught by O'Brien, in order to automatically gather and analyze information relating to the maintenance of a plurality of assets, so as to maximize pertinent and industry wide data to facilitate increasingly informed purchasing decisions in the future (O'Brien paragraph 2).

Owens, on the other hand, teaches a computer readable product embodied on computer readable media readable by a computing device (col. 3, lines 14-18).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the Intermediate Accounting, to include a computer readable product embodied on computer readable media readable by a computing device, as taught by Owens, in order to automatically gather and store information.

Regarding claims 3, 7-8 and 10-11 and 17-18, the combination of Intermediate Accounting and Owens substantially discloses the claimed invention, however, the combination does not disclose instructions for weighing the value of each model; determining the values of a predetermined date; the date of commercial release; a data stream containing the purchaser orders; and reading the machine type out of a data field in the purchase order.

O'Brien, on the other hand, teaches instructions for weighing the value of each model (paragraph 16; paragraph 137; paragraphs 75-77; paragraphs 158-162; paragraphs 163-167); determining the values of a predetermined date (paragraph 16; paragraph 137; paragraphs 75-77; paragraphs 158-162; paragraphs 163-167); the date of commercial release (paragraph 16; paragraph 137; paragraphs 75-77; paragraphs 158-162; paragraphs 163-167); a data stream containing the purchaser orders (paragraph 37; paragraph 156; paragraph 158); and reading the machine type out of a data field in the purchase order (paragraph 37; paragraph 156; paragraph 158).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combination, to include instructions for weighing the value of each model; determining the values of a predetermined date; the date of commercial release; a data stream containing the purchaser orders; and reading the machine type out of a data field in the purchase order, as taught by O'Brien, in order to capture and retain information relating to cost and utilization of an asset in order to facilitate better procurement and other business decisions (O'Brien, paragraph 5).

Response to Arguments

Applicant's arguments filed September 20, 2007 have been fully considered but they are not persuasive.

Applicants remark that O'Brien does not teach the features: the models of the machine type; determining a value of the models; calculating the average value of the models; weighting the value of each model as a function of predicted purchasing trends of models; and the value of the models are derived from the manufacturer's base manufacturing cost.

The Examiner does not agree. The Examiner notes the combination of Intermediate Accounting, Owens and O'Brien teaches the features above. O'Brien teaches a benchmark heuristic to generate a benchmark value from the pool of potential benchmarking information. The benchmark value represents some relationship to the data values of a particular characteristic or set of characteristics. If a target asset (value of acquired asset) is being compared to the pool of potential benchmark information, data values for one or more asset characteristics of the target asset can be compared to the benchmark values for one or more asset characteristics in the pool of potential benchmarking information. (Paragraph 161) O'Brien teaches the benchmark value is numerical, which can be aggregated, averaged or otherwise manipulated or processed (paragraph 162). The benchmark information system is related to a particular asset against similar information for an entire group of similar assets. The system provides users with the ability to define the group of assets included in a particular analysis. (Paragraph 15) O'Brien further teaches benchmarking pool assets which can be selected on the basis of a shared characteristic, a shared data value for a particular

characteristic (paragraph 159). Asset selection for benchmarking purposes should have some relevant characteristic or data value (paragraph 159). The benchmark characteristics include the type of asset (the type or model) paragraph 16). O'Brien further teaches benchmarking asset characteristics which can be defined by virtually unlimited number of asset characteristics. The asset characteristics can have identical characteristics such as most assets can have an asset type characteristic; some similar characteristics, such as assets will have financial and accounting characteristics; and some totally different characteristics. (Paragraph 155) The data value can be the cost, such as the purchase price of the particular asset (paragraph 156). The asset characteristics can include virtually any information relating to the asset. One category is the asset-type information, which includes the type, model, manufacturer and other related information. Another category is the accounting information which can include the purchase price, costs incurred after purchaser due to maintenance work or other enhancement, depreciation, and other financial and accounting information. Accounting information can include such metrics as average or total cost per a period of time. (Paragraph 158) O'Brien also teaches benchmarking pool assets which can be selected on the basis of shared characteristic and a shared data value for a particular characteristics, such as all vehicles with a purchase price less than \$20,000 (paragraph 159). The selection of the characteristics related to the benchmark pool assets that are to be included in the pool of benchmark can be selected for benchmarking analysis. The characteristics can be some financial or accounting characteristics (paragraph 166). Comparison among similar functions of assets can be pooled together for benchmarking

purposes and various accounting and cost characteristics can be benchmarked for the entire pool of assets. The resulting aggregate and average benchmark values can be compared to the promised or estimated characteristics of asset that is being considered. Using the system it may be possible for a seller or manufacturer to provide some performance standards and costs. (paragraph 169) O'Brien teaches maintenance information used to generate maintenance tracking reports and comprehensive invoices listing both labor and part costs. The maintenance history of a particular asset or class of assets may be reviewed and analyzed in detail for specific trends of interest. (Paragraph 93)

Such benchmark value represents some relationship to the data values of a particular characteristic or set of characteristics; the benchmark value is numerical, which can be aggregated, averaged or otherwise manipulated or processed; the benchmark information system is related to a particular asset against similar information for an entire group of similar assets; if a target asset (value of acquired asset) is being compared to the pool of potential benchmark information, data values for one or more asset characteristics of the target asset can be compared to the benchmark values for one or more asset characteristics in the pool of potential benchmarking information; the asset characteristics which include asset type information and accounting and financial information; benchmarking pool assets which includes the selection of characteristics to be analyzed and the comparison of assets based on similar functions pooled together which includes accounting and financial information; and maintenance history of a particular asset or class of assets may be reviewed and analyzed in detail for specific

trends of interest are considered the models of the machine type; determining a value of the models; calculating the average value of the models; weighting the value of each model as a function of predicted purchasing trends of models; and the value of the models are derived from the manufacturer's base manufacturing cost.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5,950,171 to Madell discloses a system for determining hypothetical book value.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARISSA THEIN whose telephone number is (571)272-6764. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3627

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mtot
December 10- 2007

/Michael Cuff/

Primary Examiner, Art Unit 3627